

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of:

Group Art Unit: 3714

Daniel L. McConnell, et al.

Examiner: Coburn, Corbett B.

Serial No.: 09/832,718

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Title: A SYSTEM AND METHOD FOR USE OF A PERSONALLY PORTABLE  
VIDEO DEVICE FOR VIEWING A LIVE EVENT

Board of Patent Appeals and Interferences  
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APPELLANT'S REPLY BRIEF UNDER 37 CFR 41.41

This Reply Brief is in response to the Examiner's Answer mailed on 08/13/2009. This Reply Brief is not a substitute Appeal Brief. Any ground for rejection in Examiner's Answer that is not refuted herein is considered by Appellant to have been sufficiently argued in the Appeal Brief such that no further comment is needed. Arguments herein focus on errors in the Examiner's Answer.

On pages 7 and 8 of the Examiner's Answer, the Examiner discusses the "receiver" and "display device", but in doing so, he is not using these terms in a way consistent with the actual language of claim 7 which requires "a respective plurality of **portable display units each containing a multi-channel receiving device and a video display device.**" The claimed "portable display units" contain both a "receiving device" and a "display device", and thus the claim requires both the receiving device and the display device to be portable. Simonelli's receiving device 32 and display devices 22, 24 are not portable, but are fixed within the housing 6. And while Yoshimatsu's head-mounted display of FIGs. 6 and 7 is portable, his receiving device 15 is not portable.

Thus, modifying Simonelli with the head-mounted display of Yoshimatsu yields only the use of a head-mounted display within the fixed-position housing 6 of Simonelli, and thus the combination fails to establish a *prima facie* case for obviousness.

The Examiner further argues on page 7 of the Answer that "any pair of video goggles must have a device that receives a video signal." However, the Examiner is ignoring the fact that claim 7 requires that the "receiving device" is "receiving the locally transmitted live-action wireless communication signals directly from the transmitters". Thus, the claimed "receiving device" is a wireless receiver which cannot properly be said to be part of "any pair of video goggles". Thus, the modification of Simonelli with Yoshimatsu fails to teach the claimed portable wireless receiving device either expressly or somehow inherently as part of a head-mounted video goggle display.

At the top of page 8 of the Answer, the Examiner states that "The location of this receiver would not patentably distinguish over the prior art." However, it is not the location but rather the claimed portability of both the receiving and display devices that is at issue. The Examiner dismisses the Appellant's "freedom of personal movement" argument as not being commensurate in scope with the claims; however, the Appellant has claimed a "portable display unit" and it is this "portable" limitation of the claims that provides the freedom of personal movement for the user. This is argued by the Appellant because the combination of Simonelli and Yoshimatsu fails to arrive at a device which provides such portability or freedom of movement, thereby further demonstrating the lack of a *prima facie* case for obviousness.

Regarding claim 9, both the final rejection and the Examiner's Answer focus on the fact that profit is a known motivator, and that it would be obvious to rent something. However, the limitations of claim 9 include more than just the step of renting. Claim 9 includes "offering the portable display units for rent to the attendees for use to enhance views ... from their respective designated viewing areas to a preferred viewing

location..." Thus, it is not the simple step of renting that is claimed as being patentable, but rather, the step of renting a device with the capability of enhancing the view of someone in the "cheap seats" to a better viewing location. Thus, claim 9 includes not only the step of renting something, which is the aspect focused on by the Examiner, but also the step of the use of the device in a particularly novel way to alter the viewing perspective of an attendee at an event. The mere existence of a prior art profit motive does not provide the requisite teaching to establish a *prima facie* case for the obviousness of the specific additional method steps of claim 9. Dependent claim 9 is a specific application of the broader method of independent claim 7, and the specific application includes both the commercial steps of "renting" and the technical step of "use to enhance views ... from their respective designated viewing areas to a preferred viewing location." In both the final rejection and the Answer, the Examiner has focused on the commercial step and has not even addressed the novel technical application of the method which makes it particularly desirable for renting. Thus, no *prima facie* case for obviousness has been established.

Furthermore, the Examiner states that the Appellant's argument (that the prior art teaches away from the claimed invention because a prior art viewing location is fixed with the seat arrangement, and seats with less desirable viewing perspectives are normally sold at a lower price) is an immaterial argument because "Neither Simonelli nor Yoshimatsu describes the pricing structure contained in Appellant's argument." However, the Examiner has based the rejection of claim 9 not only on Simonelli and Yoshimatsu, but also on "official notice" that the profit motive is well known. Thus, the Appellant's argument is, in fact, directed to the applied prior art which includes the officially noticed profit motive. Since the prior art teaches that each seat has only one viewing perspective, and the claimed method allows any given seat to have numerous viewing perspectives, the prior art can be said to teach away from the claimed invention. Whereas in the prior art there were only a limited number of seats on the 50 yard line, the claimed invention allows for an unlimited number of attendees to enjoy the 50 yard

line view no matter where they are seated, thereby overcoming a limitation of the prior art and facilitating the generation of additional revenue from seats with less desirable viewing perspectives. The invention of claim 9 includes the novel steps of both enhancing the view and charging rent for that enhancement.

The Appellant has argued that claims 10 and 11 are patentable because the applied prior art does not teach providing camera views to attendees at an event along with other content, and allowing the attendees to select between the camera views and the other content. The Examiner states that the Appellant's arguments are not commensurate with the claim scope because the Examiner believes that the claim scope does not say who selects the content to be displayed: i.e. the attendee or the service provider. However, claims 10 and 11 depend from independent claim 7, which includes the limitation of "displaying images ... individually selected by each of the respective attendees." Dependent claim 10 particularly requires "selected alternative viewing by the attendees". The Appellant asserts that this claim language is unambiguous that the attendees are doing the selecting. If the Examiner has any uncertainty in interpreting this claim language, he should interpret the claim language in view of the specification, and the specification consistently teaches that the attendees are the ones who make the selections. See for example, page 14, lines 7-9 "each individual attendee may experience a visual perspective that is personally selected to be most pleasing to that particular attendee/viewer." However, instead of interpreting the claim language in view of the specification, the Examiner attempts to show that the Appellant's arguments are not commensurate with the claim scope by suggesting that the service provider may be the one selecting the content to be viewed, and he does this by viewing claim 11 and asking the question "who would attend a football game ... and choose to spend his time watching ads?" The Examiner is hoping that the answer to his question is that "no one would choose to watch ads; therefore, it must be the service provider who selects the content." However, as described in the specification at page 14, line 21 through page 15, line 1, millions of viewers of the NFL Super Bowl

watch that game primarily because they want to watch the ads. The specification further explains that attendees may also be enticed into viewing ads by delivering ads in conjunction with supplemental entertainment content or promotions. So, if in lieu of using the specification to guide the interpretation of the claim language, one were to be guided by the answer to the Examiner's question, it would appear that the Appellant's arguments are, in fact, commensurate with the claim scope because it is the attendees who select the content to be viewed in the claims. The rejection of claims 10 and 11 is based upon Simonelli and Yoshimatsu plus "official notice" that displaying advertising is well known; however, that combination does not teach the claimed method where the attendees make the selection of what is being viewed, so no *prima facie* case for obviousness of the claims has been established.

Respectfully submitted,

A handwritten signature in cursive script that reads "David G. Maire".

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